

REMARKS

This responds to the Office Action mailed on November 7, 2005, and the references cited therewith.

Claim 11 was amended. Claims 1-31 are now pending in this application.

§112 Rejection of the Claims

Claims 4, 6, 7, 10, 15, 18, 19, 20, 24, 26, and 27 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement.

Claims 4, 15, and 24 describe funding of intellectual property protection for inventors. Support for such claims may be found in the claims themselves as filed, and additionally, at least on page 3, lines 20-26.

Claims 6, 19 and 26 mention access to a selected group of potential customers. Support for such claims may be found in the claims themselves as filed, and additionally, at least on page 3, lines 18-26, which refer to innovators, evaluators and potential users of the inventions. Further, users may be excluded as described in last paragraph on page 3.

Claims 7, 20 and 27 describe a royalty on inventions. Support for such claims may be found in the claims themselves as filed, and additionally, at least on page 11, lines 11-14 specifically recite a royalty.

Claims 10 and 18 screening and validating descriptions. Support for such claims may be found in the claims themselves as filed, and additionally, at least on page 10, lines 6-10 and element 40 in FIG. 5.

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The claim has been amended pursuant to the suggestion of Examiner. It is not believed to be a narrowing amendment.

§102 Rejection of the Claims

Claims 1-31 were rejected under 35 U.S.C. § 102(e) for anticipation by Hunter et al. (U.S. Patent No. 6,298,327). The rejection is respectfully traversed, as Hunter et al. is not

believed to describe each and every element claimed. As such, a proper prima facie case of anticipation has not been established.

Hunter et al., describes a system for authoring invention disclosures and for evaluating the probably patentability and marketability of a disclosed invention. However, it does so in a captive environment. In other words, it allows people other than the inventor, but associated with the inventor, such as technology managers or sponsors to evaluate disclosures that have been authored. The presently claimed invention is directed externally. In other words, it is directed at providing access to people who are not directly associated with the inventor to search for innovations that have been described, and view the innovations as well as evaluations of the innovations. The claims reflect different versions of this that clearly distinguish the teachings of Hunter et al.

The Office Action indicates that Hunter et al. describes “a database for storing the descriptions of inventions and evaluations by class and providing search facilities via the network for potential customers not related to the innovators to find inventions {See Fig. 2, Element 32 and Column 24, Lines 60-62, wherein this reads over “abstract subclass Records Databases 31 and abstract subclass Text Files Databases 33 inherent behavior (member functions or methods) from super class Databases 32”}”.

The cited portions of Hunter et al., merely describe the structure of a database. The claim language recited specifically includes “search facilities via the network for potential customers not related to the innovators to find inventions.” The cited portions do not describe this feature. Further, Hunter et al., in Col. 2, lines 43-50 describes that the system “enables inventors to adequately disclose (communicate) the characteristics of their inventions to their technology manager and research sponsor...” Unrelated potential customers are not included, and further, there is no specific teaching of search facilities via a network for potential customers. Another portion of Hunter et al., describes the use of a non-enabling disclosure for use by technology managers to attract commercial interest at Col. 8, lines 31-34, but again, no teaching that potential customers can search via a network.

Since at least one element is lacking in the Hunter et al., a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Independent claim 11 recites making the database selectively viewable to potential customers of the invention who are not related to the innovators. Hunter et al., does not describe making the database available to unrelated parties. The Office Action cites Col. 18, lines 30-31 as describing this feature. Such cited text refers to expert objects, not to potential customers. It is not seen how such cited text describes the claim language.

Independent claim 22 recites making the invention input and recommendation available to selective independent customers via network connection. The Office Action cites Col. 17, lines 8-10 as describing this element. However, the cited language of Hunter et al., simply describes a portion of an invention disclosure that is drafted through use of the system, wherein the disclosure identifies problems involved with the prior art. It is not seen how this teaching corresponds to the cited element of making information available to selective independent customers via network connection.

Independent claims 29 and 31 distinguish Hunter et al., for the same reasons as claim 22, in that it also recites: making “the invention input and recommendation available to selective independent customers via network connection.”

Each of the dependent claims depend from a claim that is believed allowable. Applicant reserves the right to separately argue additional distinctions at a later date, and hereby traverses any official notice or inherency arguments that may have been made.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

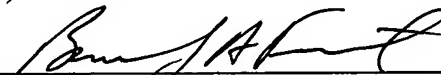
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7th day of February, 2006.

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